UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL E. CARROLL and MATTHEW P. SIESS

Appeal No. 2006-0328
Application No. 09/450, 558

HEARD: March 7, 2006

Before FRANKFORT, BAHR and NAPPI, **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 17, 22 through 39, and 44 through 61.[1] For the reasons stated *infra* we affirm-in-part the examiner's rejection of these claims.

Invention

The invention relates to a system for presenting a document with formula based links to another document. See page 1 of appellants' specification.

1 Lacking any rejection from the examiner, the appeal of claims 18 through 21 and 40 through 43 is dismissed.

Claim 1 is representative of the invention and is reproduced below:

1. A system for retrieving a main document with a reference to an insert document for inclusion in the main document comprising:

a data storage mechanism that stores the main document with a formula that resolves to a reference to an insert document, the insert document including contents for the main document;

a shared resource database, accessible by a plurality of clients of the system, that stores one or more insert documents that may be referenced within a main document;

a document destination module that opens the main document and extracts the formula;

a formula resolution module that resolves the formula to derive a value for the reference;

a document retrieval module that uses the reference to retrieve the insert document; and

a document insertion module that inserts the insert document into the main document in a document location point specified.

References

The references relied upon by the examiner are:

Crow et al. (Crow)	6,442,651	Aug. 27, 2002 (effectively filed Oct. 28, 1997)
Appleman et al. (Appleman)	6,226,648	May 1, 2001 (filed Nov. 4, 1998)
Poole et al. (Poole)	6,006,242	Dec. 21, 1999 (filed Apr. 5, 1996)
Donohue et al. (Donohue)	5,987,480	Nov. 16, 1999

Cate Richards (Richards), *Using Lotus® Notes 4.5*, Que, pg. 9 (1997).

David Raggett, World Wide Web Consortium, *HTMS 3.2 Reference Specification*, W3C Recommendation (January 14, 1997).

Rejection at Issue

Claims 1, 2, 6, 7, 11, 14, 22 through 26, 29, 30, 33 through 35, 37, 38, 44 through 48, 51, 52, 55 through 57, 59 and 60 stand rejected under 35 U.S.C. § 102(e) as being as being anticipated by Donohue. Claims 3, 8, 12 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Donohue in view of Appleman. Claims 4, 9 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Donohue in view of Appleman and Poole. Claims 5, 10, 32 and 54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Donohue in view of World Wide Web Consortium. Claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over Donohue in view of Poole. Claims 17, 36, 39, 58 and 61 stand rejected under 35 U.S.C. § 103 as being unpatentable over Donohue in view of Crow. Claims 27, 28, 31, 49, 50 and 53 stand rejected under 35 U.S.C. § 103 as being unpatentable over Donohue in view of Using Lotus™ Notes. We note that the examiner's rejection of claims 17 through 24 and 39 through 43 under 35 U.S.C. § 112, first paragraph and second paragraph has been withdrawn, see page 16 of the answer.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise,

reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and the examiner, and for the reasons stated *infra* we sustain the examiner's rejection of claims 1, 2, 6, 7, 11, 14, 22 through 26, 29, 30, 33 through 35, 37, 38, 44 through 48, 51, 52, 55 through 57, 59 and 60 under 35 U.S.C. § 102 and the examiner's rejection of claims 3, 8, 12, 15, 27, 28, 49, and 50 under 35 U.S.C. § 103. However, we will not sustain the examiner's rejection of claims 4, 5, 9, 10, 13, 16, 17, 31, 32, 36, 39, 53, 54, 58, and 61 under 35 U.S.C. § 103.

As a preliminary matter we note that on pages 36 through 38 of the brief, appellants argue that an amendment, dated November 26, 2003, submitted after the examiner's final rejection was improperly denied entry. However, the refusal by the examiner to enter the appellants' amendment after final rejection relates to a petitionable matter and not to an appealable matter. See In re Schneider, 481 F.2d 1350, 1356-57, 179 USPQ 46, 51 (CCPA 1973) and In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967). See also Manual of Patent Examining Procedure (MPEP) (8th Ed., August 2001) § 1002.02(c), item 3(g) and § 1201. Thus, the relief sought by the appellants would have been properly presented by a petition to the Commissioner under 37 CFR §§ 1.127 and 1.181 instead of by appeal to this Board. Accordingly, we will not further consider this issue.

Findings regarding the Donohue Reference.

We find that Donohue teaches a system for delivering documents having dynamic content. See abstract.

1. The documents are created using a template written in a markup language. The preferred embodiment is described as using Hyper Text Markup Language (HTML) and Hyper Text Transfer Protocol (HTTP), however other mark up languages such as Standard Generalized Markup Language (SGML) and Virtual Reality Markup Language are also known and other protocols such as File Transfer Protocol (FTP) are discussed. See column 1, lines 50 –54, line 66 through column 2 line 7, column 4, lines 39 through 43 and column 14, lines 21 through 26.

2. Data in the data source is stored in name/value pairs. See column 7 lines 45 through 47.

3. The interface with the data source retrieves content from the data source and stores the content in a container class as a pool of name/value pairs. For example, for a given user-id the interface function retrieves all of the other name/value pairs, which are linked to the user-id. See column 7, line 59 through column 8, line 9.

4. The data source and the templates can be stored on separate computers or servers. See column 7, lines 34 through 37 and column 8, line 10.

5. The system makes use of different templates with the same content but

which are designed to be compatible with different browsers. See column 12, lines 32 through 34.

6. The templates contain control symbols "@" which identify markers. See column 4, lines 38 through 43.

7. The markers identify dynamic tags and flow directives. See column 4, lines 44 through 58, column 8, lines 10 through 24.

8. Dynamic tags take the form of "@name@" and insert into the document the value associated with the name in the pool of name/value pairs stored in the container. See column 8, lines 63 through 64.

9. Flow directives can take two forms, "If" and "Loop". The "If" flow directive is identified by the form "@if condition @X@end@" and tests whether the condition is true and if so outputs X into the template. The "Loop" flow directive is identified by the form "@loop@Z@nameX@nameY@@/loop" and is used to output to the template any number of names. See column 8, line 65 though column 9, line 15.

10 . The flow directives "If" and "Loop" function can act on content within the pool of name/values within the container. See column 11, line 63 through column 12, line 26.

11. A template parsing function reads the templates and identifies the control symbols associated with the markers. See column 10, lines 49 through 59.

12. There are several library functions, which perform the flow directive functions. See column 10, lines 60 through column 11 line 20.

13. A library function populates the template with the values from the data source. See column 7, lines 20 through 24.

Rejection of claims 1, 2, 6, 7, 11, 14, 22 through 26, 29, 30, 33 through 35, 37, 38, 44 through 48, 51, 52, 55 through 57, 59 and 60 under 35 U.S.C. § 102(e)

The examiner's rejection of 1, 2, 6, 7, 11, 14, 22 through 26, 29, 30, 33 through 35, 37, 38, 44 through 48, 51, 52, 55 through 57, 59 and 60 under 35 U.S.C. § 102(e) is set forth on pages 4 through 9 of the Answer.

Claim 1.

Appellants assert, on page 8 of the brief, that Donohue teaches inserting stored textual content into a main document and not inserting documents into a main document as claimed. Appellants argue that the examiner's interpretation of the claim term "insert document" as including data that may be inserted into a main document is improper. Appellants assert, on pages 8 and 9 of the brief:

> The specification indicates that the insert document includes data (See specification, page 7, lines 4-5). A document that includes data is not the same as data itself, because an insert document may include, for example, bitmaps, voice, movies, images, etc (See specification, page 8, lines 7-8).

As such, appellants argue that Donohue does not teach the invention of claim 1.

We disagree with appellants' asserted claim interpretation. In analyzing the scope of the claim, office personnel must rely on appellants' disclosure to properly determine the meaning of the terms used in the claims. ***Markman v. Westview Instruments, Inc.***, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed.

Cir. 1995). "[I]nterpreting what is *meant* by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.'" (emphasis original) ***In re Cruciferous Sprout Litigation,*** 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing ***Intervet America Inc v. Kee-Vet Laboratories Inc.,*** 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989). Appellants' specification, on page 7, identifies that the insert document "should be understood to include data that may be inserted into a main document." Further, appellants' specification states "[e]ssentially, the insert document as used herein may be understood to be any separable portion of a main document." Thus, we consider the scope of the claim term "insert document" to be any separable portion of the main document, and as such includes textual content or data, which may be inserted into the main document.

As stated *supra*, we find that Donohue teaches a system where data is inserted into templates. We consider the templates to meet the claimed main document and the data inserted into the template, (Donohue's "value") in response to the marker, to meet the claimed insert document. Accordingly, we sustain the examiner's rejection of claim 1.

On page 9 of the brief, appellants assert that independent claims 6, 11 and 14 are patentable for the same reasons as claim 1. Thus, we group claims 6, 11 and 14 with claim 1 and sustain the examiner's rejection for the reasons stated with respect to claim 1.

Claims 2 and 7.

With respect to claims 2 and 7, appellants argue, on pages 9 and 10 of the brief:

> Donohue merely discloses using a dynamic name tag to obtain a value. The claimed invention recites "receives a reference and determines the name of the insert document to be retrieved." The examiner is equating Donohue's name tag with Appellants' reference and Donohue's value with Appellant's name of the insert document. This interpretation is inconsistent with Appellants' claim language.

We disagree with appellants. As stated *supra* with respect to claim 1 we find that the examiner's equating Donohue's values with the claimed insert document is consistent with the scope of the claim. Claim 1 recites a main document "with a formula which resolves into a reference to an insert document", "a formula resolution module that resolves the formula to derive a value for the reference", "a document retrieval module that uses the reference to retrieve the insert document." Claim 2 is dependent upon claim 1 and adds the limitation of a document identification module that "receives a reference and determines the name of the insert document to be retrieved based on the reference." Thus, we consider the scope of the claim to include a formula that is used to create a reference to an insert document, and that the formula resolves to identify the name of the insert document and a value. Further, appellants' specification, on page 9, identifies that "the formula may comprise a combination of functions and fields. The functions may yield output based on input values. The fields may comprise input values based on information provided by the system, other programs, or other modules." Thus, we consider the scope of the term formula

to include a function, which acts on a value.

We consider the control values/symbols identifying markers (see finding no. 6 regarding the teachings of Donohue) to meet appellants' claimed formulas. These control markers contain functions (see finding Nos. 7, 8 and 9 regarding the teachings of Donohue) which when resolved derive into a value, i.e. the outcome of the "If" statement or "Loop" statement is a value(see findings Nos. 8 and 9 regarding the teachings of Donohue). These control markers also resolve to a name of an insert document (see finding Nos. 8 and 10 regarding the teachings of Donohue) and insert the associated value or data (see finding no. 13 regarding the teachings of Donohue). Thus, we consider the limitations of claims 2 and 7 to be shown by Donohue and sustain the examiner's rejection of claims 2 and 7.

Rejection of claims 22 and 44.

Appellants argue, on page 10 of the brief, that claims 22 and 44 recite the limitation "wherein the main document is referenced to a plurality of insert documents". Appellants argue that Donohue discloses a variable correlation system, and that one skilled in the art would not equate Donohue's plurality of variables with the claimed plurality of documents.

We are not persuaded by appellants' arguments. As stated *supra* with respect to claim 1, we consider Donohue's template and values to meet the claimed main document and insert document. Donohue depicts one such template in figure 2, and the Appendix to the patent, in which several markers

with references to different insert documents are shown. Thus, we consider the limitations of claims 22 and 44 to be shown by Donohue and we sustain the examiner's rejection of claims 22 and 44.

Rejection of claims 23 and 45.

On page 11 of the brief, appellants state that claims 23 and 45 recite the limitation "wherein the insert document is referenced to a plurality of main documents". Appellants argue:

> Donohue does not disclose the plurality of main documents, and Donohue does not disclose an insert document referenced to a plurality of main documents. Even if Donohue does disclose a plurality of document templates, the reference does not disclose wherein the insert document is referenced to a plurality of main documents.

We disagree with appellants. As stated *supra* with respect to claim 1, we consider Donohue's template and values to meet the claimed main document and insert document. Further, we find that Donohue teaches that some of the templates contain the same information (see finding no. 5 regarding the teachings of Donohue) and as such contain the same markers and associated references. Thus, Donohue teaches a plurality of main documents, templates, with references to the same insert document. Thus, we consider the limitations of claims 23 and 45 to be shown by Donohue and we sustain the examiner's rejection of claims 23 and 45.

Rejection of Claims 24 and 46.

On page 12 of the brief, appellants argue that claims 24 and 46 recite "wherein the main document is stored separately from the insert document in order to reduce the amount of disk space required to store the main document." Appellants argue that the examiner has ignored the limitation and that Donohue does not address or deal with the problem of reducing the amount of storage space.

In response the examiner states on pages 19 and 20 of the answer, that "the examiner does not regard the clause beginning with the words 'in order to' in each of these claims to further limit the scope of claim because the clause merely recites an effect of implementing the recited method step or system element but do not further limit or define the step or element being recited."

We concur with the examiner's rationale. Claim 24 recites "The system of claim 1, wherein the main document is stored separately from the insert document in order to reduce the amount of disk space required to store the main document." Claim 46 recites a similar limitation. Thus, claim 24 is drawn to a system or apparatus; the limitation "in order to reduce the amount of disk space required to store the main document" does not describe a feature of the system but rather a rationale for storing the documents separately. As stated *supra* with respect to claim 1, we consider Donohue's template and values to meet the claimed main document and insert document. We find that Donohue teaches that the templates and the insert documents, stored in the data source, can be in separate computers (see finding no. 4 regarding the teachings of Donohue). We

consider that one skilled in the art would recognize that because Donohue's system stores templates and insert values separately for each user, the system would require less disk space than storing a series of complete documents for each user. See for example column 3, lines 11 through 15. Thus, we consider the limitations of claims 24 and 46 to be shown by Donohue and we sustain the examiner's rejection of claim 24 and 46.

Rejection of claims 25 and 47.

Appellants argue, on page 13 of the brief, that the examiner has ignored the limitation in claims 25 and 47, which recite, "in order to enable efficient modification of the insert document that is referenced to multiple main documents." Appellants further argue that Donohue does not disclose storing the main document separately from the insert document in order to enable efficient modification of the insert document.

The examiner's response to appellants' argument is the same as discussed *supra* with respect to claims 24 and 46 and we concur with the examiner for much the same reasons. Claims 25 recites "[t]he system of claim 1, wherein the main document is stored separately from the insert document in order to enable efficient modification of the insert document that is referenced to multiple documents." Claim 47 recites a similar limitation. Thus, claim 25 is drawn to a system or apparatus, the limitation "in order to enable efficient modification of the insert document that is referenced to multiple documents" does not describe a feature of the system but rather states a

rationale for storing the documents separately. As indicated *supra* with respect to claim 1, we consider Donohue's template and values to meet the claimed main document and insert document. We find that Donohue teaches that the templates and the insert documents, stored in the data source, can be in separate computers (see finding no. 4 regarding the teachings of Donohue). Further, we find that Donohue discloses modification of the insert documents in that Donohue discusses new users creating accounts, thereby creating new entries into the database. See column 4, lines 21 through 25. We consider that one skilled in the art would recognize that because Donohue's system stores templates and insert values separately for each user, the system would require less work by the user administering the system, and thereby be more efficient than creating a series of complete documents for each user. See for example column 3, lines 11 through 15. Thus, we consider the limitations of claims 25 and 47 to be shown by Donohue and we sustain the examiner's rejection of claim 25 and 47.

Rejection of claims 26 and 48.

With respect to claims 26 and 48, appellants argue, on page 14 of the brief:

> [T]he portion of Donohue relied on by the Examiner (Donohue col. 7, lines 15-17 and col. 17, lines 37-42) refers to storing a plurality of templates and a data source, but does not disclose storing a main document in a second database and an insert document in a first database.

The examiner states on pages 6 and 7 of the August 28, 2003 office action:

> Donohue et al. teach storing the insert document in a first database (Donohue et al., col. 7, lines 37-42) and also teach that the main document is stored in a second database inasmuch as they teach storing templates on the web server (Donohue et al., col. 7, lines 15-17) which comprises a database under the broadest reasonable interpretation of the term "database."

We concur with the examiner's rationale. As stated *supra* with respect to claim 1, we consider Donohue's template and values to meet the claimed main document and insert document. We find that Donohue teaches that the templates and the insert documents, stored in the data source, can be in separate computers (See finding no. 4). Thus, we consider the limitations of claims 26 and 48 to be shown by Donohue and sustain the examiner's rejection of claims 26 and 48.

Rejection of claims 29, 30, 51 and 52.

With regard to claims 29, 30, 51 and 52, appellants argue, on page 14 of the brief, the claims require the documents to be non-HTML documents. Appellants argue that Donohue does not disclose the main documents and the insert documents as being non-HTML documents.

We are not persuaded by appellants' arguments. Claims 29 and 51 recite limitations limiting the main document to a non-HTML document. Claims 30 and 52 recite limitations limiting the insert document to a non-HTML document. We find that though Donohue discusses a template as being written in HTML,

Donohue also identifies that other mark-up languages can be used (see finding no. 1 regarding the teachings of Donohue). Further, Donohue identifies that the insert documents are stored in a database in name/value pairs, we find no disclosure that the name/value pairs are limited to HTML data, and we consider that one skilled in the art would recognize the data as a non-HTML document. Accordingly, we sustain the examiner's rejection of claims 29, 30, 51 and 52.

Rejection of claims 33 and 55.

Regarding the rejection of claims 33 and 55, appellants argue on page 16 of the brief:

> Donohue fails to disclose a formula resolution module. One of ordinary skill would not equate the Appellant's formula with a variable correlation disclosed by Donohue. Therefore, Donohue fails to disclose a formula resolution module that resolves a formula to a link, said link corresponding to one or more documents, wherein said link is used to identify and retrieve one or more insert documents.

The examiner responds to this argument by stating, on page 22 of the answer, that Donohue teaches dynamic tags that are resolved to retrieve data to be inserted into a document. Further, the examiner asserts Donohue teaches web documents which contain text and tags which provide instructions.

We concur with the examiner. Claim 33 recites the limitation "wherein the formula resolution module resolves a formula to a link, said link corresponding to one or more documents, wherein said link is used to identify and retrieve one or more insert documents." Claim 55 contains a similar limitation. The term link is used in appellants' specification on page 10, to be a connection between a

reference in a formula and a specific insert document. We interpret the term in claims 33 and 55 as a connection between a reference in a formula and a specific insert document. As stated *supra* with respect to claims 1 and 2, we consider the control values/symbols identifying markers (see finding no. 6 regarding the teachings of Donohue) to meet appellants' claimed formulas. These control markers contain functions (see finding nos. 7, 8 and 9 regarding the teachings of Donohue) which when resolved derive into a value, i.e. the outcome of the "If" statement or "Loop" statement is a value (see findings nos. 8 and 9 regarding the teachings of Donohue). These control markers also resolve to a name of an insert document (see finding Nos. 8 and 10 regarding the teachings of Donohue) and insert the associated value or data (see finding no. 13 regarding the teachings of Donohue). We consider the control marker that contains a tag to enter a value associated with a name/value pair to meet the claimed link. Accordingly, we sustain the examiner's rejection of claims 33 and 55.

Rejection of claims 34 and 56.

With regard to claims 34 and 56, appellants assert on page 17 of the brief that the section of Donohue, which the examiner relies upon, discusses conditions for dynamic tag content flow. Appellants argue that "conditions for dynamic tags are not the same as Appellants' combination of one or more functions and one or more fields."

We are not persuaded by appellants' argument. Claim 34 contains the

limitation "wherein the formula corresponds to [a] combination of one or more functions and one or more fields." Claim 56 contains a similar limitation. We consider the scope of this limitation to include a formula, which is the combination of one function and one field. As stated *supra* with respect to claim 2, we consider the control values with identifying markers (see finding no. 6 regarding the teachings of Donohue) to meet appellants' claimed formulas. These markers contain functions (see finding nos. 7, 8 and 9 regarding the teachings of Donohue) which when resolved derive into a value, outcome of "if" statement or "Loop" statement (see findings nos. 8 and 9 regarding the teachings of Donohue). These markers also resolve to a name of an insert document (see finding nos. 8 and 10 regarding the teachings of Donohue) and insert the associated value or data (see finding no. 13 regarding the teachings of Donohue). As the "if" statement is a function and the operand of the "if" function is a field, we thus find that Donohue teaches the limitations of claims 34 and 56 and sustain the examiner's rejection thereof.

Rejection of claims 35 and 57.

Appellants argue on page 18 of the brief that claims 35 and 57 recite determining a date and generating a link for the date, whereas "Donohue retrieves a real date value and appears to stop there." Further, appellants argue that Donohue fails to disclose a formula as set forth in appellants' specification.

The examiner, replies, on page 23 of the answer "Donohue et al. disclose function 'if' including a date aOrder Date@00 (col. 7, lines 45-58, col. 9, lines 40-53, and Fig. 2)."

We concur with the examiner. Claim 35 recites " wherein the formula may be defined based on a function, wherein the function determines a date and generates a link for the determined date." Claim 57 contains a similar limitation. As stated *supra* with respect to claims 33 and 55, the term link is used in appellants' specification on page 10, to be a connection between a reference in a formula and a specific insert document and we interpret the term in claims 35 and 57 as a connection between a reference in a date and a specific insert document. Donohue describes, in column 9, lines 40-53, determining if the container contains a date and if so inserting a table connected to the date that contains order number. As Donohue describes determining a date and retrieving data connected to the date, we consider Donohue to describe the invention claimed in claims 35 and 57.

Rejection of claims 37 and 59.

Appellants argue, on page 19 of the brief, that claims 37 and 59 recite a request receiving module, which differs from Donohue's disclosure of a client computer accessing a web page URL.

The examiner responds, on pages 23 and 24 of the answer, asserting that

Donohue teaches client computers request particular documents from the server and the server responds by delivering the documents.

We concur with the examiner. Claim 37 recites "a request receiving module that receives a request from a user to open the main document." Claim 59 recites a similar limitation. As stated *supra* Donohue's template meets appellants' main document. Donohue describes upon receiving a URL from a user selecting a template and providing the requested document with insert documents to the user. See Donohue Figures 3A-3C, steps 48, 54 and 82. Thus, we find that Donohue describes the invention as claimed in claims 37 and 59.

Rejection of claims 38 and 60.

Appellants argue on page 19 of the brief:

> [C]laim 38 includes, *inter alia*, the feature "wherein the formula resolution module resolves a formula to a link, said link corresponding to one or more documents, wherein said link is used to identify and retrieve one or more insert documents." Claim 60 recites a similar feature. Donohue fails to disclose this feature.

Appellants' arguments are not commensurate with the scope of claims 38 and 60. Claim 38 is dependent upon claim 1 and recites, "wherein the reference is a link, wherein said link is other than the formula." Claim 60 is dependent upon claim 11 and recites a similar limitation. As appellants' arguments do not address the limitations of claims 38 and 60, we group claims 38 and 60 with dependent claims 1 and 11 and sustain the examiner's rejection for the reason

given with respect to claims 1 and 11.

Rejection of claims 3, 8, 12 and 15 under 35 U.S.C. § 103 as being unpatentable over Donohue in view of Appleman.

On page 22 of the brief, appellants argue that motivation to combine Donohue and Appleman provided by the examiner is improper and that neither of the references provides a teaching or suggestion to be combined as the examiner asserts. Appellants' stated reason is that Donohue does not hard code design elements because Donohue uses dynamic tags.

The examiner states, on page 25 of the answer, that Donohue does not teach enabling the user to create the main document with the reference to an insert document. The examiner relies upon Appleman to teach this limitation. The examiner reasons that one would be motivated to use Appleman as Appleman's approach "eliminates or reduces the need to hard code design elements in a web page, promoting greater 'design and maintenance flexibility'. (Appleman et al., col. 9, lines 22-41)." See answer, page 25

We disagree with appellants. Claim 3 recites the limitation "the system also enables a user to create and store a main document having a reference to an insert document; wherein the document destination module enables a user to create a main document with a reference to an insert document and stores the main document with the reference separate from the insert document being referenced." As discussed *supra,* we find that Donohue discusses the main document and the insert document being stored in different locations. As the

examiner recognizes, Donohue does not teach a module which allows a user to create and store the web pages. However, it is clear that a user generates the templates. See column 3, line 15 . Appleman teaches a system where a user creates HTML documents using a template and uploads the HTML documents for web pages. See column 7, lines 51 through 59. The system then takes the uploaded HTML document and inserts files to create a suitable web page. See column 8, lines 36-37. The purpose of this system is that it "builds into the web pages HTML instructions to 'look for' missing site construction information e.g., the color set for the site." See column 9, lines 26 and 27. Appleman is concerned with making it possible to propagate changes to sites at the server without editing the HTML code. The sites discussed in Appleman correspond to the templates of Donohue, they are both in HTML code and are incomplete documents (they require additional information). Thus, we find that Donohue is silent as to how the templates are created and that Appleman provides a teaching of how to generate similar documents. Appellants' argument that Donohue does not use hard coding of design elements and therefore Appleman is not properly combined with Donohue is not well taken. The feature that Appleman adds to Donohue is that a user creates the main document. Accordingly, we will sustain the examiner's rejection of claim 3 and the claims grouped with claim 3, claims 8, 12, and 15.

Rejection of claims 4, 9 and 13 under 35 U.S.C. § 103

as being unpatentable over Donohue in view of Appleman and Poole.

With regard to claims 4, 9 and 13, appellants argue on page 23 of the brief that claims 4, 9, and 13 recite a module that allows a user to define a formula that resolves to a reference to an insert document. Appellants argue that Poole is only concerned with correlating an entity reference with a constituent portion/entity (i.e. field in a form and the appropriate reference to data).

The examiner responds, on page 27 of the answer, that Poole teaches that a user can define the formula that resolves to the insert document, citing column 5, lines 7-10. Further the examiner states: "one of ordinary skill in the art would have recognized that the user would have needed the ability to define the formula that resolves to the reference to the insert document to be included in the main document in order to ensure that the appropriate insert document was inserted."

Claim 4 is dependent upon claim 3 and recites the limitation "a formula definition module that enables a user to define a formula that resolves to a reference to an insert document to be included in the main document." Claims 9 and 13 contain similar limitations. Poole teaches a system for constructing electronic forms, which have entity references that are resolved into components such as text of graphics. See abstract. We do not find that Poole teaches that the user can define formulas. Rather, the portions of Poole, which the examiner relies upon to teach the formula definition module, appear to teach that the user

can specify the entity references. Further, while the examiner's argument that one of skill in the art would have recognized the user needs to have the ability to define a formula seems intuitive, nonetheless we do not find that Poole in combination with Donohue and Appleman provide objective evidence that teaches or makes obvious the limitations of claims 4, 9 and 13. Accordingly, we will not sustain the examiner's rejection of claims 4, 9 and 13.

Rejection of claims 5, 10, 32 and 54 under 35 U.S.C. § 103 as being unpatentable over Donohue in view of World Wide Web Consortium[2].

Appellants argue on page 25, of the brief, that claims 32 and 54 recite the main document including a predefined portion that may be defined as a background. Appellants argue that the combination of Donohue and World Wide Web Consortium do not teach these features.

In response the examiner asserts, on page 28 of the answer, that Donohue discloses that the main document includes a predefined portion but does not teach that the portion may specify the background for the main document. The examiner states "*HTML 3.2 Reference Specification* [World Wide Web Consortium] teaches on page 6 that background is an attribute of HTML's <BODY> element, and further teaches on page 7 that the background attribute can be used to specify a URL (equivalent to a formula)." Further, the examiner asserts that Appleman provides motivation to make these changes.

[2] We note that the examiner's statement of the rejection does not include Appleman, however the examiner's explanation of the rejection on page 11 of the answer refers to Appleman.

We disagree with the examiner's rationale. Claim 5 is dependent upon claim 1 and includes the further limitation "wherein the document location point comprises a background in the main document," where claim 1 identifies the location point as the point where the insert document is inserted. Claims 10, 32 and 54 contain similar limitations. Thus, the scope of claim 5 includes that the document inserted is the background of the main document. Donohue teaches that the insert document has values associated with names; in context these values are customer data in a database. Donohue is concerned with entry of data from a database into a template, which is used to create a document. Donohue teaches that the background of the document is set in the template, markup language document, not by the insert document. See Donohue appendix, line 11 "<body bgcolor=#ffffff>." We do not find World Wide Web Consortium or Appleman teach or suggest that value for the background should be provided by an insert document. Accordingly we will not sustain the examiner's rejection of claims 5, 10, 32 and 54.

Rejection of claim 16 under 35 U.S.C. § 103 as being unpatentable over Donohue in view of Poole.

Claim 16 contains the limitation "computer readable program code means for causing a computer to enable a user to define a formula that resolves to a reference to an insert document to be included in the main document." Claim 16 is similar in scope to claims 4, 9, and 13 and the examiner's rationale, on pages 12, 13 and 29 of the answer, is similar to that applied to the rejection of claims 4,

9 and 13. As discussed *supra* with respect to these claims we do not find that Poole in combination with Donohue provides objective evidence that teaches or makes obvious these limitations. Accordingly, we will not sustain the examiner's rejection of claim 16.

Rejection of claims 17, 36, 39, 58 and 61 under 35 U.S.C. § 103 as being unpatentable over Donohue in view of Crow.

Appellants state, on page 31 of the brief, that claim 61 requires the limitation of "resolving the formula continuously in order to modify said identified insert document that is inserted in the main document." Appellants state that the examiner acknowledges that Donohue does not teach this feature. Further, appellants argue that Crow, the reference the examiner relies upon to teach this feature, discloses refreshing a web object stored in cache and does not teach this feature.

In response, the examiner asserts, on pages 14 and 15 of the answer, that Crow's teaching of periodically refreshing a cache is equivalent to the claimed continuously resolving a formula including objects.

We disagree with the examiner. Claim 61 is an independent claim and recites many of the features discussed *supra*. Claim 61 also includes the limitation "resolving the formula continuously in order to modify said insert document that is inserted in the main document." Appellants' specification, on pages 14 and 15, discusses continuously resolving the formula so that if the outcome of the formula changes, the changes can be implemented in an open

main document. Thus, we consider the scope of the claim to include that the calculation of the formula is ongoing, the resolution of the formula is dynamic and changes as the variables upon which the formula is predicated change. Crow teaches a system, which periodically refreshes web documents maintained in cache. Crow teaches that this can be applied to both the web document and the document's embedded objects. The purpose of the refresh is to make sure the data is not stale. See Crow, abstract, column 4, lines 53-55. However, we consider periodically refreshing data, reloading data, to be different than performing ongoing calculation to resolve a formula like that of the present case. Thus, we do not find that Crow teaches the limitation of continuously resolving the formula and we, accordingly, will not sustain the examiner's rejection of claim 61. Nor will we sustain the examiner's rejection of claims 17, 36, 39, and 58, which contain similar limitations.

Rejection of claims 27, 28, 31, 49, 50 and 53 under 35 U.S.C. § 103 as being unpatentable over Donohue in view of Using Lotus™ Notes.

Rejection of claims 27, 28, 49 and 50.

With respect to claims 27, 28, 49 and 50, which recite use of a "LotusNotes" database, appellants argue, on page 36 of the brief, that there is no "teaching, suggestion or motivation to modify Donohue to include the teachings of Richards. Richards simply discloses a LotusNotes database. Appellants submit that there would have been no motivation to combine a LotusNotes database, in particular, with the method and system for producing and delivering

documents having embedded dynamic content of Donohue."

The examiner asserts, on page 15 of the answer, that Richards provides motivation to use LotusNotes as the database as Richards states that LotusNotes databases are easy to develop.

Claim 27 is dependent upon claim 26 and recites the limitation "wherein the first database is a LotusNotes database." Initially, we note that appellants' specification on page 14 identifies that "LotusNotes" is a trademark, and as such the scope of the limitation may be ambiguous as the meaning of the term is not static. See MPEP 608.01(v). Nonetheless, appellants have not contested the examiner's finding that Richards teaches the limitation. Accordingly, we only consider whether the examiner has established a proper motivation to support a holding of obviousness.

As stated *supra* we find that Donohue discloses the limitations in claim 26. Further, Donohue teaches that the data is stored in a database. (See finding no. 2 regarding the teachings of Donohue). Donohue is silent as to which database format to use. Richards asserts that the advantage of LotusNotes is that it is user friendly. We consider this sufficient suggestion to support the examiner's finding that it would have been obvious to use a LotusNotes database as the database in Donohue's system. Accordingly we sustain the examiner's rejection of claim 27 and the claims grouped with claim 27, claims 28, 49 and 50.

Rejection of claims 31 and 53.

Appellants argue on page 15 of the brief:

> [c]laims 31 and 53 recite, *inter alia*, "wherein the insert document stored in said first database can be modified to a modified insert document, wherein the modified insert document is inserted into the main document in response to the user selecting the main document." This feature is not disclosed by Donohue.

In response, on page 21 of the answer, the examiner asserts that Donohue inherently teaches that the insert document in a database can be modified to be a modified insert document.

We disagree with the examiner's rationale. Though, as stated *supra* with respect to claims 25 and 47, we find that Donohue teaches that the insert document is stored separately to enable efficient modification of the insert document, we do not find evidence to indicate that it is inherent that a modified insert document is inserted into the main document in response to the user electing the main document as claimed. Accordingly, we will not sustain the examiner's rejection of claims 31 and 53.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief or by filing a reply brief have not been considered and are deemed waived by appellants (see 37 CFR § 41.37(c)(vii)). Support for this rule has been demonstrated by our reviewing court in ***In re Berger***, 279 F.3d 975, 984, 61 USPQ2d 1523, 1528-1529 (Fed. Cir. 2002) wherein the Federal Circuit stated that because the appellants did not contest the merits of the rejections in his brief to the Federal Circuit, the issue is waived. ***See also In re Watts***, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

Conclusion

In summary, we sustain the examiner's rejection of claims 1, 2, 6, 7, 11, 14, 22 through 26, 29, 30, 33 through 35, 37, 38, 44 through 48, 51, 52, 55 through 57, 59 and 60 under 35 U.S.C. § 102 and the examiner's rejection of claims 3, 8, 12, 15, 27, 28, 49, and 50 under 35 U.S.C. § 103. However, we will not sustain the examiner's rejection of claims 4, 5, 9, 10, 13, 16, 17, 31, 32, 36, 39, 53, 54, 58, and 61 under 35 U.S.C. § 103. The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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